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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/777,597

02/11/2004

Paul Y. Kim

SF-4

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06/01/2006

LANGLOTZ PATENT WORKS, INC.

PO BOX 759

GENOA, NV 89411

EXAMINER

REHM, ADAM C

ART UNIT

PAPER NUMBER

2875

DATE MAILED: 06/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/777,597

Applicant(s)

KIM, PAUL Y.

Examiner

Adam C. Rehm

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-7, 9, 11-16, 18 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by JIGAMIAN ET AL. (US 2004/0042211), which provides a flashlight (11) comprising:

- A single lamp having opposed electrodes (66) connected to a controller (164);
- Said controller being intermediately-located and operable to deliver different selected power having a plurality of connected inputs/outputs (164, Fig. 14);
- A power storage element having opposed electrodes connected to the controller (237, Fig. 2);
- Switch contacts connected directly to the controller (88, Fig. 14);
- A single, axially moveable switch/button operable to be incremented through a sequence of states and responsive to application/release of

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pressure via connection between an input from the controller and a selected one of the outputs (88, Paragraph 82, Lines 11-28);

- Said states comprising off and at least two different brightness states (Paragraph 82, Lines 11-28); and
- A resistor network wherein operation includes use of a selected resistor (42, Paragraph 63).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 8, 10, 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over JIGAMIAN ET AL. (US 2004/0042211) in view of applicant's admitted prior art. JIGAMIAN ET AL. discloses the claimed invention including an axially-moveable button, but does not disclose a rotatable element having conducting contacts rotatably responsive to axial movement of the button for cycling LEDs off and on in varying phases. However, applicant admits that a single push-button switch having a rotating element that contacts a different contact in each state and thereby connected to a lamp circuit is known in the art (Paragraph 11). It would have been obvious to one of ordinary skill in the art at the time of invention to modify JIGAMIAN ET AL. and use the rotatable element having conducting contacts rotatably responsive to axial movement of the button for cycling LEDs off and on in varying phases as taught by applicant's

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admitted prior art in order to achieve the well-known advantages of an LED including energy efficiency as well as provide simplicity via the particular single-button operation as taught by applicant's admitted prior art.

3. Claims 1, 2, 8, 12, 13 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art. Applicant admits that the following is known in the art:

- A single lamp/LED (Paragraphs 3 and 11);
- A power storage element (Paragraph 3);
- A single, axially moveable/rotating switch/button having contacts operable to be incremented through a sequence of states; each responsive to an application/release of pressure (Paragraphs 7 and 11);
- Said states comprising off and at least two different brightness states (Paragraph 11); and
- Said switch having an input and contacts/a plurality of outputs (Paragraph 7).

Response to Amendment

4. Applicant's correspondence dated 5/17/2006 has been received.

Response to Arguments

5. Applicant's arguments have been fully considered, but are not persuasive.

6. Applicant argues that JIGAMIAN ET AL. does not disclose a switch operable to be incremented through a sequence of states. Examiner concurs with Applicant's definition of "sequence", i.e. a series of states more than two. Examiner cited the text

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passage (Paragraph 82) that clearly states, "as long as button 88 is held down...light intensity increases." Applicant alleges that an open/closed switch cannot have a sequence of states. Notably, JIGAMIAN ET AL., in the aforementioned passage, discloses a resistance ladder 146 that enables the JIGAMIAN ET AL. flashlight to operate through a sequence of states. Furthermore, Applicant admits that flashlights having a switch operable through a sequence of states are known in the art (Paragraph 11).

7. Applicant argues that the JIGAMIAN switch requires the use of other elements. It should be noted that the Examiner employs the accepted meaning of "switch", i.e. a device used to turn electric current on and off or to otherwise direct its flow. Given this definition, the term switch does not necessarily consist of a single element, but can consist of a plurality of cooperating elements to achieve the switch function.

8. Applicant argues that Examiner does not evidence the position of the Office. However, Examiner has specifically cited JIGAMIAN (Lines 11-28 of Paragraph 82), which clearly discloses a switch operable to be incremented through a sequence of stages. Examiner maintains that JIGAMIAN ET AL. discloses a single switch that employs a plurality of cooperating elements to perform a single switching function that is commensurate with Applicant's claimed switch.

9. Applicant argues that JIGAMIAN ET AL. does not disclose a switch that, upon application and release of pressure, changes between states in which the lamp is operated at different brightness. However, JIGAMIAN ET AL. discloses that a change of intensity results "when push button 88 is turned on and held on for more than a few

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seconds" (Paragraph 82). Applicant alleges that the period of depression distinguishes the claimed invention from JIGAMIAN ET AL. Notably, the feature upon which applicant relies (i.e., a specific period of depression) is not recited in the rejected claim(s).

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

10. Applicant argues that the claimed invention is distinguishable because JIGAMIAN does not disclose a switch operable via an application and release of pressure that increments from one brightness state to another in sequence. However, JIGAMIAN discloses a switch that "as long as [the] button is held down, BCD signals count up and light intensity increases." (Paragraph 82, Line 16).

11. Applicant argues that the claimed invention is distinguishable because it operates through a "range" of operating states versus a "sequence" as claimed. However, JIGAMIAN discloses the switch is cyclical (Paragraph 82, Line 21). A cycle is synonymous with a sequence. It is clear that the JIGAMIAN switch is operable as claimed by applicant. Furthermore, Applicant admits that flashlights having a push-button switch that indexes through a sequence of states as the button is clicked (push-release) are known in the art (Paragraph 11). The rejection of Claim 1 is maintained.

12. Applicant argues that JIGAMIAN ET AL. does not disclose a switch that includes an "off" state in addition to different brightness states. However, JIGAMIAN ET AL. specifically discloses a button (88) that enables the flashlight to be operated through a sequence of states in addition to an off state depending on period of depression of the

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button, as admitted by Applicant (Paragraph 82). Furthermore, Applicant admits that such flashlights are known in the art (Paragraph 11). The rejection of Claim 2 is maintained.

13. Applicant argues that JIGAMIAN ET AL. does not disclose an elongated body or a switch located at an intermediate portion of the body away from the ends. However, Figure 1 illustrates an elongated body (232, Paragraph 50) with the switch located as claimed (88, Fig. 1). The rejection of Claim 3 is maintained.

14. Applicant argues that JIGAMIAN ET AL. does not disclose a switch having a plurality of outputs connected to the controller. However, JIGAMIAN ET AL. specifically discloses a switch/controller 164 having a plurality of input signals including "CLOCK, +VIN, +LAMP SENSE and PMW while the output signals are [connected to the controller including] CURRENT OFF, RELAY, TRIGGER, Hi LO POWER" (Paragraph 82). Examiner's interprets the term "switch" to have the normal meaning, i.e. a control consisting of a device for breaking or changing connections in a circuit. Notably, the controller 164 complies with the definition. Furthermore, Applicant admits that such flashlights having a switch that contacts a different contact/output in each state are known in the art (Paragraph 11). The rejection of Claim 4 is maintained.

15. Applicant argues that JIGAMIAN ET AL. does not disclose a connection between an input contact from the controller and a respective one of the output contacts. However, JIGAMIAN ET AL. discloses a switch having input and output signals and a resistance ladder for operating the flashlight through a sequence of states (Paragraph 82). It is inherent that each state requires an electrical connection made between an

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input contact and one of the output contacts. Furthermore, Applicant admits that such flashlights are known in the art (Paragraph 11). The rejection of Claim 5 is maintained.

16. Applicant argues that JIGAMIAN ET AL. does not disclose a power storage element having opposed electrodes each connected to the controller. However, JIGAMIAN ET AL. discloses a power storage device element/battery (237, Fig. 1). It is inherent that a battery has a positive and a negative electrode wherein each are connected to a controller/switch. Moreover, JIGAMIAN ET AL. discloses such (Fig. 15).

17. Applicant argues that JIGAMIAN ET AL. does not disclose a lamp having opposed electrodes each connected to the controller. However, JIGAMIAN ET AL. discloses a xenon arc lamp (66). It is inherent that xenon arc lamps having opposing electrodes necessary to form the arc wherein each are connected to a controller/switch. Moreover, JIGAMIAN ET AL. discloses such (Paragraph 6). The rejection of Claim 6 is maintained.

18. Applicant argues that JIGAMIAN ET AL. does not disclose contacts of the switch being connected directly to the controller such that the switch does not intervene between the lamp and the power source. However, JIGAMIAN ET AL. discloses a controller/switch (164) with a plurality of contacts including switch contacts connected directly to the controller and not intervening between the lamp and power source (88, Fig. 14). The rejection of Claims 7 and 16 are maintained.

19. Applicant argues that JIGAMIAN ET AL. does not disclose a network of resistors that operates to include a selected one of the resistors in a circuit including the lamp and power source. However, JIGAMIAN ET AL. discloses a resistor network (42,

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Paragraph 63) in addition to a plurality of resistors (Fig. 10, 157, 163 and 159) in a circuit (Paragraph 36) including a lamp (66) and power source (237). Applicant argues that JIGAMIAN does not disclose a resistor network connected and operated as claimed, i.e. "a network of resistors to include one of the selected resistors in a circuit including the lamp and the power source." Clearly, the claim language provides no distinction from any circuit used in a flashlight having a light and battery. The rejection of Claim 9 is maintained.

20. Applicant argues that JIGAMIAN ET AL. does not disclose a reflector having an optical axis wherein the single lamp is positioned on the optical axis. However, JIGAMIAN ET AL. clearly discloses such a reflector having an optical axis with the lamp positioned on the axis for maximum collimation (274, Paragraph 50). The rejection of Claim 11 is maintained.

21. Applicant argues that JIGAMIAN ET AL. does not disclose a lamp having an electrical input contact and a plurality of electrical output contacts. As previously discussed, JIGAMIAN ET AL. specifically discloses a switch/controller 164 having a plurality of input signals including "CLOCK, +VIN, +LAMP SENSE and PMW while the output signals are CURRENT OFF, RELAY, TRIGGER, Hi LO POWER" (Paragraph 82). Examiner's interprets the term "switch" to have the normal meaning, i.e. a control consisting of a device for breaking or changing connections in a circuit. Notably, the controller 164 complies with the definition.

22. Applicant argues that JIGAMIAN ET AL. does not disclose a switch being operable to be incremented through a sequence of stages. As previously discussed,

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JIGAMIAN ET AL. states, "as long as button 88 is held down...light intensity increases" and discloses a resistance ladder 146 that enables the JIGAMIAN ET AL. flashlight to operate through a sequence of states (Paragraph 82).

23. Applicant argues that JIGAMIAN ET AL. does not disclose a plurality of states having an electrical connection made between the input contact and a respective one of the output contacts. As previously demonstrated, JIGAMIAN ET AL. discloses a switch having input and output signals and a resistance ladder for operating the flashlight through a sequence of states (Paragraph 82). It is inherent that each state requires an electrical connection made between an input contact and one of the output contacts. Furthermore, Applicant admits that such flashlights are known in the art (Paragraph 11). The rejection of Claim 12 is maintained.

24. The rejection of Claim 13 was previously addressed above with respect to Claim 2 and is maintained.

25. Applicant argues that JIGAMIAN ET AL. does not disclose a single switch. Examiner previously indicated a single switch (164). Furthermore, Applicant admits that JIGAMIAN has single button operation and that such flashlights having a single switch are known in the art (Paragraph 11). The rejection of Claim 14 is maintained.

26. Applicant argues that JIGAMIAN ET AL. does not disclose a controller element connected to the lamp, to the power storage element and to each of the contacts of the switch. Examiner previously indicated a controller element (164), a lamp (66) to the power storage element/battery (237) connected to the contacts of the switch (Figs. 2 and 10). The rejection of Claim 15 is maintained.

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27. The rejection of Claim 18 was previously addressed above with respect to Claim 9 and is maintained.

28. The rejection of Claim 20 was previously addressed above with respect to Claim 11 and is maintained.

29. Applicant argues that there is insufficient motivation to combine JIGAMIAN ET AL. with Applicant's admitted prior art and the combination was based on improper hindsight reasoning. Notably, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

30. In regards to substituting a multi-contact switch with a rotating element, Applicant admits that a flashlight requiring the use of two hands is disadvantageous in an emergency (Paragraphs 8-9) and thereafter admits that single-switch flashlights having a rotating element for cycling through different brightness levels are known in the art (Paragraph 11). It would have been obvious to one of ordinary skill in the art at the time of invention to modify JIGAMIAN ET AL. and use the switch design as taught by Applicant in order to provide an easily adjustable flashlight ideal in an emergency.

31. In regards to LEDS, the benefits of LEDs are notoriously well known in the art as evidenced by Applicant, e.g. "shorter run time of an incandescent lamp" (Paragraph 10). It would have been obvious to one of ordinary skill in the art at the time of invention to

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modify JIGAMIAN ET AL. and use the LED as taught by Applicant in order to obtain the well known advantages of efficiency.

32. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Applicant admits the advantages of both the switch and use of LEDs.

Conclusion/Correspondence


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam C. Rehm whose telephone number is 571.272.8589. The examiner can normally be reached on M-F 9-5:30 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on 571.272.2378. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ACR
5/26/2006


Thomas M. Sander
Art Unit 2875
Primary Examiner